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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/914,868 08/19/97 BJORNARD

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MM91/1221

EXAMINER

DORSEY & WHITNEY LLP
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CHANG, A	
ART UNIT	PAPER NUMBER

2872
DATE MAILED:

12/21/00

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/914,868

Applicant(s)

BJORNARD ET AL.

Examiner

Audrey Y. Chang

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-15,17-22,31-43 and 47-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-15,17-22,31-43 and 47-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Remark

1. This Office Action is in response to applicant's amendment filed on October 6, 2000 which has been entered as paper number 21.
2. By this amendment, claims 49-53 have been newly added by the applicant. Claims 1-5, 7-15, 17-22, 31-43 and 47-53 remain pending in this application.
3. The rejections to claims 33-34 and 40-42 under 35 USC 112, first paragraph, with regard to an added new matter are still hold.

Reissue Applications

4. The supplemental reissue oath/declaration filed on October 6, 2000 with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414. The supplemental reissue oath/declaration identify "every error" in the patent to corrected in this reissue application but it fails to specify the particular error, the "every error" can not be based to support the reissue application.

5. Claims 9, 10, 19-22, 31-32, 33, 34, 35, 36, 37, 39, 43, 47 and 50-53 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion as follows: The declaration given by the applicant on August 19, 1997 states that the reissue application is filed to correct the error concerning the "DC reactive sputtering deposition of the layer materials to a temperature sensitive substrate having a melting point lower than glass" to make it a broader by using "reactively sputtering deposition". The cited claims however have failed to remedy the "error" since they fail to claim this feature. Furthermore, they fail to claim the "same invention", as required in reissue application, as in

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the original patent, (PN. 5,579,162). The applicant is respectfully reminded, claims 9 and 10 in the reissue application are different from claims 9 and 10 in the original patent since the essential feature "DC reactively sputtering" is not included in the claims of the reissue application. Claims 33, 34, 35, 39, 43, 47 and 50-53 recite various anti-reflection coating that do not contain the essential features concerning the composition of reactively sputtering materials and having specific thickness for the layers. They are therefore considered to be "entirely distinct inventions" from the original patent. In re Weiler 229 USPQ 637 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5, 8, 11-13, 15, 18, 38, 40 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent issued to Okaniwa (PN. 5,667,880) in view of the patent issued to Dickey et al (PN. 5,372,874).

The reasons for rejection based on the teachings of Okaniwa and Dickey et al are set forth in the previous Office Action dated May 25, 2000.

8. Claims 4, 7, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent issued to Okaniwa in view of the patent issued to Dickey et al.

The reasons for rejection are set forth in the previous Office Action dated May 25, 2000.

Response to Arguments

9. Applicant's arguments with respect to claims 1-5, 7-8, 11-15, 17-18, 38, 40, and 48 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument which states that the cited Dickey reference does not teach that the substrate can be plastic, the examiner wishes to respectfully direct the applicant's attention to Dickey reference column 6, lines 19-23 which read s as follows: "the present invention may be in the form of a Rock-type anti-reflection coating. The coating or layer system may be formed on a glass or plastic substrate 14".

In response to applicant's argument which states that the cited Dickey reference does not relate to the layer contains tin oxide and zinc oxide, the examiner respectfully disagrees for the reasons stated below. The Dickey reference teaches an anti-reflection coating which may be formed of the well known Rock-type structure which comprises alternative layers of high and low refractive index materials and the Dickey reference teaches specifically that tin oxide and zinc oxide having index refraction of 1.9 and are part of a group of suitable and well known high refractive index layer materials in the art, (please see columns 2-3). It is further common to one skilled in the art to select particular materials in the group of well known refractive index materials as preferred to design a coating for particular purpose but it does not exclude other materials in the group from being used to make the Rock type anti-reflection coating since they all are well known suitable high refractive layer materials.

In response to applicant argument concerning the new matter rejection of claims 33-34 and 40-42, the applicant is respectfully reminded that the specification never give support for the second and fourth layers being selected from different groups of materials, (please see column 6, lines 50-59).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

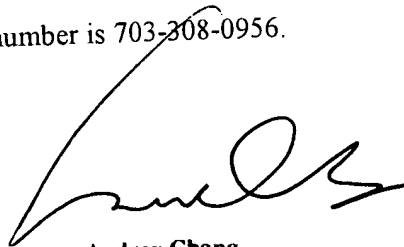
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Audrey Y. Chang whose telephone number is 703-305-6208. The examiner can normally be reached on Monday-Friday (8:00-4:30), alternative Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703-308-1637. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

A. Chang
December 19, 2000



**Audrey Chang
Primary Examiner
Technology Center 2800**